

REMARKS

The Specification has been amended. Claims 1, 7, 14, and 81 have been amended. Claims 16-17 have been cancelled without prejudice or disclaimer as to the subject matter contained therein. Therefore, claims 1-8, 12-15, 18-24, and 81-83 are pending in the present application. It is respectfully submitted that no new matter has been presented and no new issues have been raised by the present response. Further examination and reconsideration of pending claims 1-8, 12-15, 18-24, and 81-83 are respectfully requested.

The undersigned would like to thank the Examiner for his time and assistance during the telephone conference of April 3, 2007.

Objections to the Specification

The disclosure was objected to because the Specification was missing the co-pending application serial numbers on page 7. The Specification has been amended to include the serial numbers that were missing on page 7. Accordingly, removal of the objections to the Specification is respectfully requested.

Rejection under 35 U.S.C. § 112, first paragraph

Claims 1-8, 12-24, and 81-83 were rejected under 35 U.S.C. § 112, first paragraph, as based on a disclosure that is not enabling. Claims 1-8, 12-24, and 81-83 were also rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. As noted above, claims 16-17 have been cancelled thereby rendering the § 112, first paragraph, rejections of these claims moot. As will be set forth in detail below, the § 112, first paragraph, rejections of claims 1-8, 12-15, 18-24, and 81-83 are respectfully traversed.

The claims have been amended to positively recite a pipette tip.

The Office Action states: "The tip and its relationship to the nozzle is considered critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure." (Office Action -- page 13). Applicants respectfully submit that the tip and its relationship to the nozzle are not critical or essential to the practice of the invention. Nevertheless, to expedite prosecution, independent claim 1 has been amended to recite, in part: "a nozzle portion extending from a point on said body portion...; a pipette tip mounted to an end of the nozzle

portion in fluid communication with the nozzle portion."

Independent claim 81 has been amended to recite similar limitations. Support for these amendments to claims 1 and 81 can be found in the Specification as originally filed, for example, on page 3, lines 27-28 and page 7, lines 30-31. As such, the above-referenced amendments to claims 1 and 81 do not present new matter, and entrance of these amendments to claims 1 and 81 is respectfully requested. Claims 1 and 81 have, therefore, been amended to include a positive recitation of the pipette tip thereby clarifying the tip and its relationship to the nozzle portion. In addition, Applicants respectfully submit that the disclosure of the present application, when filed, contained sufficient information regarding this subject matter of claims 1 and 81 and claims dependent therefrom as to enable one skilled in the pertinent art to make and/or use the claimed invention.

The Specification is enabled.

The Office Action also states: "the specification is not enabled such that structure is provided where liquid cannot enter the nozzle." (Office Action -- page 13). Applicants respectfully traverse this assertion at least for the reason that the Specification describes such a piston member on page

7, lines 19-28, page 9, line 24 to page 10, line 2, and in matter incorporated into the Specification on page 7, lines 24-28. Nevertheless, to expedite prosecution, independent claim 1 has been amended to recite, in part:

wherein the base allows the tip to remain mounted to the nozzle portion when the pipette is standing on the surface and any liquid in the tip is prevented from moving back into the body portion because of the downward angle θ of the nozzle portion.

Independent claim 81 has been amended to recite similar limitations. Support for these amendments to claims 1 and 81 can be found in the Specification as originally filed, for example, on page 9, lines 24-28. As such, the above-referenced amendments to claims 1 and 81 do not present new matter, and entrance of these amendments to claims 1 and 81 is respectfully requested. In addition, Applicants respectfully submit that the disclosure of the present application, when filed, contained sufficient information regarding this subject matter of claims 1 and 81 and claims dependent therefrom as to enable one skilled in the pertinent art to make and/or use the claimed invention.

The claims comply with the written description requirement.

Claims 1-8, 12-15, 18-24, and 81-83 were rejected as failing to comply with the written description requirement based on the contention that "The independent claims 1 and 81 contain new matter as explained above (see Response to Arguments)." (Office Action -- page 13). The Office Action states in the section titled "Response to Arguments":

Where is there support in the specification for the device having structure that will not allow liquid to move into the nozzle portion? The examiner fails to find support for such a limitation. The claim is thus considered to contain new matter. (Office Action -- page 4).

Applicants respectfully submit that the limitation "a piston member operable for controlling flow of the liquid aspirated into the pipette tip such that the liquid cannot enter into the nozzle portion and thereby cannot move through the body portion" previously recited in independent claims 1 and 81 constitutes subject matter that was described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention (for at least the reasons set forth in the Amendment filed by Applicants in the present case on January 5, 2007, which is incorporated by reference as if fully set forth herein). Nevertheless, in order to expedite prosecution, the

subject matter in claims 1 and 81 contended to be new matter has been replaced with the following limitation:

wherein the base allows the tip to remain mounted to the nozzle portion when the pipette is standing on the surface and any liquid in the tip is prevented from moving back into the body portion because of the downward angle θ of the nozzle portion.

As noted above, support for these amendments to claims 1 and 81 can be found in the Specification as originally filed, for example, on page 9, lines 24-28. Therefore, this subject matter is described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As such, Applicants respectfully submit that claims 1 and 81 and claims dependent therefrom do not contain subject matter that is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Conclusion

For at least the reasons set forth above, therefore, claims 1 and 81 and claims 2-8, 12-15, 18-24, and 82-83

dependent therefrom are enabled by the disclosure.

Furthermore, for at least the reasons set forth above, claims 1 and 81 and claims 2-8, 12-15, 18-24, and 82-83 dependent therefrom comply with the written description requirement. Accordingly, removal of the § 112, first paragraph, rejections of claims 1-8, 12-15, 18-24, and 81-83 is respectfully requested.

Rejection under 35 U.S.C. § 102(b)

Claims 1-2, 4-5, 12-13, and 15-24 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,246,559 to Clifford (hereinafter "Clifford"). As noted above, claims 16-17 were canceled thereby rendering the § 102 rejections of these claims moot. As will be set forth in detail below, the § 102 rejections of claims 1-2, 4-5, 12-13, 15, and 18-24 are respectfully traversed.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), MPEP § 2131. The cited art does not disclose all limitations of the currently pending claims, some

distinctive limitations of which are set forth in more detail below.

The cited art does not teach a handheld pipette including a body portion having a lowermost surface forming a base as presently claimed.

In particular, it is respectfully submitted that Clifford does not teach every element recited in amended independent claim 1, including:

- "A handheld pipette including:...a body portion having a vertical central axis longer than a horizontal central axis...wherein the body portion has a lowermost surface forming a base extending perpendicular or substantially perpendicular to the vertical central axis of the body portion and permitting the pipette to stand on a surface with the vertical central axis of the body portion perpendicular or substantially perpendicular to the surface".

Support for these amendments to claim 1 can be found in the Specification, for example, on page 4, lines 21-22 and page 9, lines 24-25, the drawings as originally filed, for example, Fig. 3 as originally filed, and the claims as originally filed, for example, claim 16 as originally filed.

Clifford discloses a force fed cuvette. The Office Action states that "It is only required that the device have the ability to sit on a surface. As illustrated by the figures there is nothing that would prevent one from sitting the device of Clifford on a surface (such as a table edge) where it could remain 'stable'." (Office Action -- page 9). Applicants respectfully traverse this assertion.

In particular, Clifford contains no teaching, explicitly, inherently, or otherwise, that the device of Clifford could sit on a surface such as a table edge. For example, as shown in Figs. 1 and 2 of Clifford, the lowermost surface of the "the body portion" of the device of Clifford is the lowermost surface of holder 11. Clifford states that "capillary tube 23 extends part way up into hole 22 in plug 20 and is disposed across the bottom of holder 11 until it bends upwardly to extend into a vertical capillary hole 58." (Clifford -- col. 3, lines 20-23). Clifford also states that "The bottom end of tube 23 is bent under holder 11 and inserted up into hole 22 in plug 20." (Clifford -- col. 4, lines 6-8). Therefore, as shown in Figs. 1 and 2 of Clifford, tube 23 extends below the lowermost surface of holder 11. Since the capillary tube extends below the lowermost surface of the holder, if one were to place the device on a surface, the capillary tube extending below the lowermost surface of the holder would cause the

device to tip to one side or even to fall over thereby causing the vertical central axis of the device of Clifford to not be perpendicular or substantially perpendicular to the surface.

It appears that the Examiner recognizes the inability of the device of Clifford to stand on a surface as presently claimed since the Office Action suggests that the device of Clifford could stand if placed on the edge of a table (perhaps such that the capillary tube extending below the lowermost surface of the holder is positioned beyond the edge of the table). However, there is no teaching, or even suggestion, in Clifford or in knowledge generally available to one of ordinary skill in the art known to Applicants that the device of Clifford could be placed on the edge of a table as suggested in the Office Action such that the device of Clifford could stand as presently claimed. In particular, there is no explicit or inherent teaching, or even suggestion, in Clifford or in knowledge generally available to one of ordinary skill in the art known to Applicants that the device of Clifford could stand as presently claimed on the edge of a table as suggested in the Office Action (e.g., without falling off the edge of the table due to the center of gravity of the device and/or due to the position of the capillary tube extending below the lowermost surface of the holder of the device of Clifford). For example, as shown in Figs. 1 and 2 of Clifford, the portion of the

capillary tube extending below the lowermost surface of holder 11 is positioned near the center of the device of Clifford. Therefore, if the device of Clifford was placed on an edge of a table such that the capillary tube extending below the lowermost surface of the holder is positioned beyond the edge of the table as the Examiner appears to suggest, the center of the device of Clifford would also be positioned beyond the edge of the table, which would cause the device of Clifford to fall off of the edge of the table.

For at least the reasons set forth above, therefore, Clifford does not explicitly, inherently, or otherwise teach a handheld pipette including a body portion having a vertical central axis longer than a horizontal central axis and having a lowermost surface forming a base extending perpendicular or substantially perpendicular to the vertical central axis of the body portion and permitting the pipette to stand on a surface with the vertical central axis of the body portion perpendicular or substantially perpendicular to the surface, as recited in claim 1. As such, Clifford does not teach all limitations of claim 1.

The cited art does not teach a handheld pipette including a pipette tip as presently claimed.

In particular, Clifford also does not teach other elements recited in amended independent claim 1, including:

- "A handheld pipette including:... a pipette tip mounted to an end of the nozzle portion in fluid communication with the nozzle portion...at least one button...operable...to effect aspiration of liquid into the pipette tip mounted to the end of the nozzle portion and dispensing of the liquid from the pipette tip mounted to the end of the nozzle portion".

As noted above, support for these amendments to claim 1 can be found in the Specification as originally filed, for example, on page 3, lines 27-28 and page 7, lines 30-31.

The Office Action states that "Clifford discloses a pipetting device with an angled nozzle 64. The device is capable of aspirating and dispensing fluid into and from a cuvette 25." (Office Action -- page 14). It appears, therefore, that the Office Action is reading the "pipette tip" on cuvette 25 of Clifford. However, as shown in Figs. 1 and 2 of Clifford, cuvette 25 is not mounted to any end of member 64. In addition, cuvette 25 is not in fluid communication with member 64. Instead, cuvette 25 is mounted to capillary 23 and is in fluid communication with capillary 23 (since the fluid

flows from capillary 23 into cuvette 25) and may also, therefore, be in fluid communication with anything that is in fluid communication with the end of capillary 23 not adjacent to cuvette 25. Therefore, based on the Examiner's contention that member 64 of the device of Clifford is a nozzle, cuvette 25 of the device of Clifford is not a pipette tip as presently claimed since the cuvette is not mounted to an end of member 64 and is not in fluid communication with member 64.

Clifford also states that "A long finger-like member 64...includes an enlarged end 65 dimensioned to snugly receive a test tube 70." (Clifford -- col. 3, lines 32-35). Clifford also states that "the enlarged portion 65 can be slipped into test tube 70 and as finger 64 moves further into it...by covering vent 63, fluid in test tube 70 will be pressurized so as to be driven into capillary tube 23." (Clifford -- col. 3, lines 44-49). Therefore, the device of Clifford may include a test tube mounted to an end of member 64 in fluid communication with capillary 23. However, the test tube will not be in fluid communication with member 64 (since the fluid in the test tube will flow into capillary 23 not member 64). As such, test tube 70 is not a pipette tip as presently claimed.

In addition, according to the teachings of Clifford, fluid is aspirated from test tube 70 mounted to an end of member 64. Therefore, test tube 70 is not a pipette tip as presently

claimed since liquid is not aspirated into the test tube.

Furthermore, according to the teachings of Clifford, fluid is dispensed into the test tube. Therefore, test tube 70 is not a pipette tip as presently claimed since liquid is not dispensed from the test tube.

Clifford further states that "It is possible of course to manipulate piston 48 and use it as a pump by inserting the end of finger 64 into the washing solution." (Clifford -- col. 4, lines 59-61). Although Clifford teaches that the finger may be inserted into a washing solution, Clifford does not teach that a vessel containing the washing solution is mounted to the end of finger 64. In addition, a vessel containing the washing solution will not be in fluid communication with finger 64. Instead, the vessel containing the washing solution will be in fluid communication with capillary 23 since the washing solution would move from the vessel into the capillary. Therefore, such a vessel is not a pipette tip as presently claimed since the vessel is not mounted to an end of a nozzle portion in fluid communication with the nozzle portion.

In addition, according to the teachings of Clifford, the washing solution is aspirated from the vessel. Therefore, the vessel is not a pipette tip as presently claimed since washing solution is not aspirated into the vessel. Furthermore, according to the teachings of Clifford, the washing solution is

dispensed into the vessel. Therefore, such a vessel is not a pipette tip as presently claimed since the washing solution is not dispensed from the vessel.

Furthermore, Clifford does not teach, explicitly, inherently, or otherwise, that a pipette tip as presently claimed could be mounted to finger 64 or any other element of the device of Clifford.

For at least the reasons set forth above, therefore, Clifford does not explicitly, inherently, or otherwise teach a handheld pipette that includes a pipette tip mounted to an end of a nozzle portion in fluid communication with the nozzle portion and into which liquid is aspirated and from which liquid is dispensed, as recited in claim 1. As such, Clifford does not teach all limitations of claim 1.

The cited art does not teach a handheld pipette configured such that a pipette tip does not touch a surface when the pipette is standing on the surface as presently claimed.

In particular, Clifford does not teach additional elements recited in amended independent claim 1, including:

- "A handheld pipette...wherein at least the angle θ of said nozzle portion to the vertical central axis of said body portion and length of said pipette tip mounted to the end of said nozzle portion are

selected such that said pipette tip does not touch the surface when the pipette is standing on the surface".

Support for these amendments to claim 1 can be found in the Specification as originally filed, for example, on page 4, lines 21-24 and page 9, line 24 to page 10, line 2 and in the claims as originally filed, for example, in claims 16 and 17 as originally filed.

The Office Action states that "And furthermore and operator can choose to connect a pipette of any desired dimensions including one of the length as mentioned in the claim." (Office Action -- page 10). Applicants respectfully traverse this assertion.

First, for at least the reasons set forth above, Clifford does not teach, explicitly, inherently, or otherwise, that a pipette tip as presently claimed can be mounted to member 64, which the Examiner contends is the nozzle of the device of Clifford. Therefore, Clifford does not teach, or even suggest, mounting any pipette tip whatsoever to the end of member 64, let alone "a pipette of any desired dimensions including one of the length as mentioned in the claim."

In addition, as set forth in claim 1, it is not just the length of the pipette tip that is selected such that the pipette tip does not touch a surface on which the pipette is

standing (at least the angle of the nozzle portion to the vertical central axis of the body portion is also selected such that the pipette tip does not touch the surface on which the pipette is standing). However, even if an operator attempts to mount a pipette tip to the device of Clifford and the operator selects the length of the tip as suggested in the Office Action, Clifford does not teach explicitly, inherently, or otherwise that an angle of member 64 to a vertical central axis of a body portion of the device of Clifford is or can be selected. Instead, it appears that the angle of member 64 with respect to a vertical central axis of the body portion of the device of Clifford is fixed due to threaded boss portion 68 and coaxing threaded hole 69 as shown in Fig. 1 of Clifford. In addition, Clifford does not teach explicitly, inherently, or otherwise that the threaded boss portion and the coaxing threaded hole are configured such that the angle of member 64 is selected with respect to a vertical central axis of the body portion of the device of Clifford.

Furthermore, Clifford provides no teaching, or even suggestion, explicitly, inherently, or otherwise, for selecting a length of any element of the device of Clifford or an angle of member 64 (contended by the Examiner to be the nozzle of the device of Clifford) such that the element does not touch a surface on which the device of Clifford is placed. In

addition, Clifford does not teach, or even suggest, explicitly, inherently, or otherwise that the device of Clifford is configured such that any element of the device of Clifford does not or should not touch a surface on which the device of Clifford is placed.

The Office Action also states that "What if the surface is only flat in the region on which the base sits, but the surface has a steep rise thereafter?" (Office Action -- page 10). However, one of ordinary skill in the art would readily understand that situations in which the presently claimed handheld pipette will be used include laboratory and other similar situations. In addition, one of ordinary skill in the art would readily understand that most "surfaces" in such situations on which the handheld pipette might be placed are typically substantially flat (e.g., to prevent hazardous chemicals to spill or dangerous and expensive equipment to fall over and be damaged). Therefore, since the Examiner has provided no evidence suggesting that the handheld pipette might be placed on a surface, which is only flat in the region on which the base sits, but has a steep rise thereafter, it appears that the Examiner is at least partially basing the rejection on a surface that may theoretically exist in some

hypothetical situation in which the handheld pipette might be used. However, as set forth above, common knowledge does not suggest that one of ordinary skill would attempt to place a handheld pipette on such a theoretical surface since such surfaces are rare if at all present in situations in which the pipette might be used. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. MPEP 2144.03. Therefore, should the rejections of claim 1 be maintained on this basis, Applicants respectfully request documentary evidence supporting this position.

Furthermore, there is nothing to suggest that if the pipette were to be placed on such a hypothetical surface, at least the angle of the nozzle portion to the vertical central axis of the body portion and a length of a pipette tip mounted to the end of the nozzle portion could not be selected as presently claimed such that the pipette tip does not touch the surface when the pipette is standing on the surface.

The Office Action further states that "Applicant is attempting to define the structure relative to unclaimed

elements with which the device may be used." (Office Action -- page 10). However, even if Applicants are "attempting to define the structure relative to unclaimed elements with which the device may be used," such limitations as presently claimed are definite and define the structure of the presently claimed handheld pipette as accurately as the subject matter permits. For example, a claim limitation specifying that a certain part of a pediatric wheelchair be "so dimensioned as to be insertable through the space between the doorframe of an automobile and one of the seats" was held to be definite. *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986). The court stated that the phrase "so dimensioned" is as accurate as the subject matter permits, noting that the patent law does not require that all possible lengths corresponding to the spaces in hundreds of different automobiles be listed in the patent, let alone that they be listed in the claims. MPEP 2173.05(b). Therefore, the limitations set forth above are definite and define the structure of the presently claimed handheld pipette.

For at least the reasons set forth above, therefore, Clifford does not explicitly, inherently, or otherwise teach a handheld pipette including a nozzle portion, where at least an angle θ of the nozzle portion to a vertical central axis of a

body portion and a length of a pipette tip mounted to the end of the nozzle portion are selected such that the pipette tip does not touch a surface when the pipette is standing on the surface, as recited in claim 1. As such, Clifford does not teach all limitations of claim 1.

The cited art does not teach a handheld pipette configured such that any liquid in a pipette tip is prevented from moving back into a body portion as presently claimed.

In particular, Clifford does not teach still other elements recited in amended independent claim 1, including:

- "A handheld pipette including:...a body portion...wherein the body portion has a lowermost surface forming a base...wherein the base allows the tip to remain mounted to the nozzle portion when the pipette is standing on the surface and any liquid in the tip is prevented from moving back into the body portion because of the downward angle θ of the nozzle portion".

As noted above, support for these amendments to claim 1 can be found in the Specification as originally filed, for example, on page 9, lines 24-28.

For at least the reasons set forth above, Clifford does not teach that the device of Clifford includes a base that allows the pipette to stand on a surface. In addition, Clifford does not teach that the device of Clifford can stand on any surface. Therefore, Clifford cannot teach a handheld pipette that includes a base that allows a pipette tip to remain mounted to the nozzle portion when the pipette is standing on a surface and any liquid in the tip is prevented from moving back into the body portion because of the downward angle θ of the nozzle portion.

Clifford also states that "To analyze a fluid sample, finger 64 is inserted into a test tube 70...After the sample has been analyzed, cuvette assembly 10 can be withdrawn from the colorimeter and test tube 70 pulled slowly from the end of finger 64." (Clifford -- col. 4, lines 31-45). Therefore, Clifford appears to teach that a test tube can remain mounted to the device when the pipette is placed into a colorimeter. However, for at least the reasons set forth above, the test tube mounted to finger 64 is not a pipette tip. In addition, for at least the reasons set forth above, Clifford does not teach, or even suggest, that a pipette tip could be mounted on finger 64 of the device of Clifford. Therefore, Clifford cannot teach a handheld pipette that includes a base that allows a pipette tip to remain mounted to the nozzle portion

when the pipette is standing on a surface and any liquid in the tip is prevented from moving back into the body portion because of the downward angle θ of the nozzle portion.

Furthermore, although Fig. 1 of Clifford shows member 64 arranged at a downward angle with respect to the vertical central axis of holder 11, Clifford does not teach, explicitly, inherently, or otherwise, or even suggest, that this downward angle prevents any liquid in the test tube from moving back into the body portion as presently claimed. Therefore, Clifford cannot teach a handheld pipette that includes a base that allows a pipette tip to remain mounted to a nozzle portion when the pipette is standing on a surface and any liquid in the tip is prevented from moving back into a body portion because of the downward angle θ of the nozzle portion.

For at least the reasons set forth above, therefore, Clifford does not teach a handheld pipette that includes a base that allows a pipette tip to remain mounted to the nozzle portion when the pipette is standing on a surface and any liquid in the tip is prevented from moving back into a body portion because of the downward angle θ of the nozzle portion, as recited in claim 1. As such, Clifford does not teach all limitations of claim 1.

The cited art does not teach a handheld pipette including at least one button as presently claimed.

In particular, Clifford does not teach further elements recited in amended independent claim 1, including:

- "A handheld pipette including:...at least one button located on the top of the body portion and operable by a thumb of the operator to effect aspiration of liquid into the pipette tip mounted to the end of the nozzle portion and dispensing of the liquid from the pipette tip mounted to the end of the nozzle portion, the at least one button being further operable such that pressing of the at least one button by the thumb of the operator initiates the aspiration and the dispensing".

Support for these amendments to claim 1 can be found in the Specification as originally filed, for example, on page 4, lines 10-18, page 8, lines 3-5, and page 11, lines 25-26 and in the claims as originally filed, for example, in claims 9-11 as originally filed.

Clifford states that "A mechanical plunger assembly 40 for cleaning and flushing cuvette 25, for example of plastic material, is provided centrally of retaining ring member 28 and slips through a drilled hole 41 therein." (Clifford -- col. 2, lines 60-63). As shown in Figs. 1 and 2 of Clifford, the

mechanical plunger assembly is located on top of the device of Clifford.

Clifford also states that "pumping downwardly on stem 50 while covering hole 54 serves to force the washing solution out of cuvette 25 via capillary tube 23." (Clifford -- col. 3, lines 17-19). Clifford also states that "a washing solution, for example, of distilled water, can be poured directly via filling hole 54 into cuvette 25 followed by a downward push applied to piston 48 while covering the top of hole 54." (Clifford -- col. 4, lines 52-55). Therefore, Clifford teaches that the mechanical plunger assembly is configured such that the plunger can be pressed to dispense washing solution from the cuvette.

However, Clifford also states that "It is possible of course to manipulate piston 48 and use it as a pump by inserting the end of finger 64 into the washing solution." (Clifford -- col. 4, lines 59-61). As would be clear to one of ordinary skill in the art, in order for the piston of Clifford to be used as a pump, while the plunger is pressed down, finger 64 could be inserted into the washing solution, and upon release of the plunger, the spring in the plunger assembly would cause the piston to rise thereby drawing washing solution into the cuvette. Therefore, it is the release of the plunger and the resulting upward motion of the plunger that initiates

aspiration of washing solution into the cuvette. In this manner, the plunger of Clifford is not configured such that pressing of the plunger initiates aspiration of the washing solution into the cuvette.

For at least the reasons set forth above, therefore, Clifford does not teach a handheld pipette including at least one button located on top of a body portion that is operable such that pressing of the at least one button by a thumb of an operator initiates aspiration of liquid into a pipette tip mounted to an end of a nozzle portion and dispensing of the liquid from the pipette tip mounted to the end of the nozzle portion, as recited in claim 1. As such, Clifford does not teach all limitations of claim 1.

The presently claimed pipette is distinguished from the prior art in terms of structure rather than function.

None of the above-referenced limitations of claim 1 constitute a manner in which the claimed pipette is intended to be employed. Instead, all of the above-referenced claim language is structurally limiting because the claim language limits the structure of the pipette. As such, the presently claimed pipette is distinguished from the prior art apparatus of Clifford in terms of structure rather than function. While features of an apparatus may be recited either structurally or

functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). MPEP 2114. Therefore, the prior art does not teach all structural limitations of the claim. As such, the claimed pipette is differentiated from the prior art apparatus of Clifford.

Conclusion

For at least the reasons set forth above, claim 1 is not anticipated by the cited art. Therefore, claims 2, 4-5, 12-13, 15, and 18-24, which depend from claim 1, are not anticipated by the cited art for at least the same reasons. Accordingly, removal of the § 102 rejections of claims 1-2, 4-5, 12-13, 15, and 18-24 is respectfully requested.

Rejections under 35 U.S.C. § 103(a)

The cited art does not teach or suggest a handheld pipette including a hook as presently claimed.

Claims 6-8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Clifford in view of U.S. Patent No. 2,796,204 to Math (hereinafter "Math"). As will be set forth in detail

below, the § 103 rejections of claims 6-8 are respectfully traversed.

The cited art does not teach or suggest all elements recited in claims 6-8, including the following limitation:

- "A handheld pipette including: a body portion... shaped to fit in an operator's hand...a hook extending from a point on said body portion which is sufficiently angularly spaced from the point from which said nozzle portion extends to permit the hook to fit over a selected portion of the operator's hand when the pipette is being held by the operator in a position of use."

The Office Action states that "It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device of Clifford to include a hook element such as that of Math." (Office Action -- page 15). The Office Action also states that "The examiner asserts that the handle element 37 may be considered a hook or the spring element 42 (as seen in the figure)." (Office Action -- page 15). Applicants respectfully traverse these assertions.

In particular, Math states that "Secured to the cap element below the tab is a handle 37, which can be grasped by the hand of the user in the manner shown in Fig. 1, so that

when the handle 37 is grasped by the forefinger, the thumb can be employed to depress the actuating bar." (Math -- col. 2, line 72 to col. 3, line 4). Therefore, Math discloses that handle 37 can be grasped by the forefinger of the user. However, there is no teaching or suggestion in Clifford, Math, or knowledge generally available to one of ordinary skill in the art known to Applicants that handle 37 could be included on the device of Clifford such that the handle could fit over a portion of an operator's hand when the device of Clifford is being held in a position of use. Therefore, contrary to the assertions in the Office Action, it would not have been obvious to one of ordinary skill in the art to modify the device of Clifford with handle 37 of Math.

In addition, Math states:

Anchored at one end to collar 40 and projecting laterally, outwardly from the housing, is an upwardly bowed leaf spring 42 bearing against the underside of the tab 36. It will thus be seen that each time the tab is depressed by the thumb of the user, to lower the actuating bar, the spring 42 will be somewhat flattened out, and subsequently, when the downward pressure is relieved, the spring 42 will shift the actuating bar in a return direction, back to its upper position. (Math -- col. 3, lines 8-16).

Therefore, if the spring of Math is fit over a portion of an operator's hand when the device of Math is being held by the

operator in a position of use, the device of Math would not be operable. In particular, as taught by Math, the device is operable by downward pressure on tab 36, the underside of which the spring bears against. Therefore, if the spring of Math is fit over a portion of the operator's hand, there would be an upward pressure on the spring and therefore on the tab by the operator's hand, which would prevent the tab from being depressed and therefore would prevent the device of Math from being usable. As such, contrary to the assertions in the Office Action, spring 42 cannot be considered a hook as presently claimed.

For at least the reasons set forth above, therefore, the combination of Clifford and Math does not teach or suggest a handheld pipette including a body portion shaped to fit in an operator's hand and a hook extending from a point on the body portion that is sufficiently angularly spaced from a point from which a nozzle portion extends to permit the hook to fit over a selected portion of the operator's hand when the pipette is being held by the operator in a position of use, as recited in claims 6-8. Consequently, the combination of Clifford and Math does not teach or suggest all limitations of claims 6-8.

For at least the reasons set forth above, claims 6-8 are patentable over the cited art. Accordingly, removal of the § 103 rejections of claims 6-8 is respectfully requested.

The cited art does not teach or suggest a handheld pipette including a button that controls ejection of a tip as presently claimed.

Claims 14 and 81-83 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Clifford in view of U.S. Patent No. 6,737,023 to Kelly et al. (hereinafter "Kelly"). As will be set forth in detail below, the § 103 rejections of claims 14 and 81-83 are respectfully traversed.

The cited art does not teach or suggest all elements recited in claim 14, including the following limitation:

- "The handheld pipette as claimed in claim 1 including a button on said body which controls ejection of a tip from said nozzle portion".

The Office Action states that "Clifford does not disclose the device as comprising a mechanism for ejecting tip."

(Office Action -- page 15). The Office Action also states:

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device of Clifford to incorporate the tip ejection mechanism as taught by Kelly et al. in order to remove and replace the tip 19 with minimal risk of injury to the user. (Office Action -- pages 15-16).

However, for at least the reasons set forth above, Clifford does not teach, explicitly, inherently, or otherwise, or suggest that a pipette tip as presently claimed could be mounted to finger 64 or any other element of the device of Clifford. Furthermore, for at least the reasons set forth above, Clifford does not suggest mounting a pipette tip as presently claimed to any element of the device of Clifford. Therefore, the cited art and common sense does not suggest incorporating any mechanism for ejecting a pipette tip into the device of Clifford since the prior art and knowledge generally available in the art known to Applicants does not teach or suggest that a pipette tip as presently claimed could be mounted thereon in the first place. As such, contrary to the assertions in the Office Action, it would not have been obvious to one of ordinary skill in the art at the time of the invention to modify the device of Clifford to incorporate any tip ejection mechanism. Therefore, the cited art does not teach or suggest a handheld pipette including a button on a body portion of the pipette which controls ejection of a tip from a nozzle portion of the pipette, as recited in claim 14.

For at least the reasons set forth above, claim 14 is patentable over the cited art. Accordingly, removal of the § 103 rejection of claim 14 is respectfully requested.

Furthermore, claims 81-83 do not include a recitation of "a mechanism for ejecting tip." Therefore, removal of these § 103 rejections of claims 81-83 is respectfully requested.

The cited art does not teach or suggest a handheld pipette that includes padding as presently claimed.

Claim 20 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Clifford in view of U.S. Patent No. 5,983,733 to Strandberg et al. (hereinafter "Strandberg"). As will be set forth in detail below, the § 103 rejection of claim 20 is respectfully traversed.

The cited art does not teach, suggest, or provide motivation for all elements recited in claim 20, including the following limitation:

- "The handheld pipette as claimed in claim 1 including padding on at least a portion of said body portion".

The Office Action states that "Clifford does not disclose the inventions as comprising a padding material." (Office Action -- page 16). The Office Action also states:

It would have been obvious to one of ordinary skill at the time of the invention to modify either of the devices of Clifford to incorporate the cushion or padding as taught by Strandberg in order to relieve or reduce fatigue to an operators hand when holding the devices. (Office Action -- page 16).

Applicants respectfully traverse this assertion.

In particular, it would not be obvious to incorporate cushion or padding on the device of Clifford. For example, Clifford states that "The present invention contemplates a cuvette assembly...which is constructed to be bodily inserted momentarily into a colorimeter for readings to be taken on the sample in the cuvette." (Clifford -- col. 1, lines 35-40). In addition, Clifford states:

an alignment detent 72 extending vertically up the side of holder 11 is provided to coact with an alignment member 73 shown in phantom lines in FIGURE 3 incorporated into an optical analyzing apparatus such as a colorimeter thereby orienting light path 31 properly disposed with respect to the orientation of cuvette 25.
(Clifford -- col. 3, lines 54-60).

Therefore, if the device of Clifford is modified by including a cushion or padding on the body portion of the device of Clifford, such cushion or padding could interfere with insertion of the device of Clifford into a colorimeter and could interfere with proper alignment of the device of Clifford in the optical analyzing apparatus. As such, modifying the device of Clifford to incorporate the cushion or padding of Strandberg may render the device of Clifford unsatisfactory for its intended purpose. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221

USPQ 1125 (Fed. Cir. 1984). MPEP 2143.01. Therefore, there is no suggestion or motivation to modify Clifford with Strandberg as suggested in the Office Action. As such, contrary to the assertions in the Office Action, one of ordinary skill in the art would not be motivated to modify the device of Clifford to incorporate the cushion or padding as taught by Strandberg. Consequently, the cited art does not teach, suggest, or provide motivation for a handheld pipette including padding on at least a portion of a body portion of the handheld pipette, as recited in claim 20.

For at least the reasons set forth above, claim 20 is patentable over the cited art. Accordingly, removal of the § 103 rejection of claim 20 is respectfully requested.

Other Remarks in the Office Action

Regarding the remarks contained in the section of the Office Action entitled "Claim Interpretations," the Office Action states that "The broad structural requirements of claim 1 is a body portion that has a longer vertical axis than horizontal axis (which is relative to one's viewing perspective)." (Office Action -- page 11). Applicants respectfully traverse this assertion.

In particular, as recognized by the Examiner, the axes are defined based at least in part on their relative dimensions. However, the dimensions of the body portion do not change depending on the perspective with which one views the body portion. Therefore, the vertical central axis and the horizontal central axis as presently claimed do not change merely by changing the perspective with which the pipette is viewed.

In addition, the presently claimed vertical central axis and horizontal central axis are not just defined based on the orientation of the body portion or the perspective of someone viewing the body portion as the Examiner appears to suggest since the axes are also defined with respect to each other (e.g., the vertical central axis is longer than the horizontal axis) and with respect to other elements of the pipette (e.g., the nozzle portion extends from a point on the body portion and at a downward angle θ to the vertical central axis). Therefore, a vertical central axis and a horizontal central axis of a body portion cannot be assigned merely based on one's viewing perspective as suggested in the Office Action.

Conclusion

This communication is believed to be fully responsive to the Office Action and every effort has been made to place the application in condition for allowance. The claims are believed to be patentable over the cited references, and a favorable Office Action is hereby earnestly solicited.

If an additional telephone interview would be of assistance in advancing prosecution of the present application, the Examiner is respectfully invited to telephone the undersigned at the number provided below.

If any fee is due in connection with the present response, the Commissioner for Patents is hereby authorized to charge the requisite fee to our deposit account number 02-0393.

Respectfully submitted,

Date: June 6, 2007

By: 

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